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REMARKS

Claims 1 – 7 and 11 – 32 are pending. The applicant respectfully requests reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 1, 4-7, 11-13, 15-19, 21, 22, and 24 – 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown, Pinnisi & Michaels, PC, www.lightlink.com/bbm, retrieved from Internet Archive Wayback Machine www.archive.org, date range: 2/24/1998 2/18/1999 ("BPM") in view of InventNet, www.inventnet.com, retrieved from the Internet Archive Wayback Machine www.archive.org, date range: 12/3/1998 – 2/9/1999. Claims 2, 3, 14, 20 and 23 were rejected under 35 U.S.C. § 103 as being unpatentable over BPM in view of Inventnet. Insofar as the rejections may be applied to the claims as amended, the rejections are respectfully traversed. For the reasons including, *inter alia*, those discussed below, each of independent claims 1, 11, 15, 21, 24, 31 and 32 is patentable over the applied references. Claims dependent therefrom are similarly patentable. The Examiner is respectfully requested to reconsider and withdraw the rejections for the reasons given below.

BACKGROUND

Background: BPM and InventNet

BPM concerns a collection of web pages, apparently produced by a US intellectual property firm, with some information about intellectual property. The portions provided by the Examiner include, *inter alia*, a page titled "Invention Disclosure Form;" a page titled "Patent Information"; a page titled "Budget Estimator for Patents;" and portion of a page titled "IP Resources on the Internet." The Office Action admits that BPM fails to disclose one or more target jurisdictions.

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Inventnet states that it is an Internet based inventor's network. InventNet is a web site with sections titled, e.g., "Patenting Help," "Inventions for Sale," "Patent Attorneys," "About InventNET," "Patent Forms," "Patent Search," "News," "Hot Links," "Prototype Work," "Product Services," and "InventNET Inventors." The Patenting Forms Section has links to USPTO forms on the USPTO web site. Inventnet includes a Patent Attorney Directory, a listing of certain patent attorneys by zip code.

Rejections under 35 U.S.C. §§ 103 and 103(a) over a combination of BPM and Inventnet

A. **There is no Prima Facie case of obviousness because the references fail to teach or suggest all claim limitations.**

To establish a *prima facie* case of obviousness with respect to a claimed invention, all the claim limitations must be taught or suggested by the prior art reference (or references when combined). *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. There must also be a reasonable expectation of success. Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The examiner bears the burden of establishing this *prima facie* case. *In re Deuel*, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995). The applicant for patent may then attack the *prima facie* case as improperly made out, or present objective evidence tending to support a conclusion of nonobviousness. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

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Where, as here, the Examiner fails to establish a *prima facie* case of obviousness, the applicant has no burden to rebut the rejection of obviousness with evidence. *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more applicant is entitled to grant of patent. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The Office Action argues that "merely providing an automatic means to replace a manual activity which accomplishes the same results is not sufficient to distinguish over the prior art." *In re Venner*, 262 F.2d 91, 95, 120 U.S.P.Q. 193, 194 (CCPA 1958). The facts in a prior legal decision, such as *Venner*, can provide precedence supporting obviousness only if the facts are sufficient similar to the present application. MPEP 2144; *In re Eli Lilly & Co.*, 902 F.2d 943, 14 U.S.P.Q.2d 1741 (Fed. Cir. 1990).

Where a claimed invention omits an element in the prior art while retaining the function of the element elsewhere in the claimed invention, the claimed invention is not obvious. *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966). In *Edge*, the claims were found unobvious over the prior art because a transparent layer in the prior art was eliminated, although the erasure function of the prior art was retained in *Edge*'s metal layer. Here also, some of the claims omit an element but retain the function, as further detailed below.

With regard to independent claim 1, the Office Action contends that BPM's online law firm marketing materials suggest or teach the invention, as claimed. The Office Action admits that BPM fails to disclose that, in response to selection by a user of one or more of the intellectual property services, initiating performance of the services, and substantially coincident with performance thereof, transacting the associated one or more fees. (Office Action ¶ 9-19).

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To the contrary, BPM fails to teach or suggest claim limitations in several claims.

Applicant provides herein non-exhaustive examples of BPM's inadequacies.

BPM and/or Inventnet do not teach or suggest, for example "determining at least one intellectual property matter" (independent claim 1). In addition, BPM and/or Inventnet fail to teach or suggest, for example, providing information on services corresponding to a particular intellectual property matter. Moreover, neither an intellectual property matter nor a service is selectable in BPM or Inventnet. Hence, BPM or Inventnet does not do anything responsive to such selection.

Further, both Inventnet and BPM fail to teach or suggest the possibility of particular intellectual property matters, that services can be provided with respect to particular intellectual property matters, and that matters may cover more than one target jurisdiction.

Recognizing that BPM fails to teach and/or suggest the invention as claimed, InventNet is cited to remedy the deficiencies. For reasons including, for example, that BPM neither teaches nor suggests such initiating performance of services, InventNet fails to remedy such deficiencies.

Additionally, with respect to claim 1, Inventnet and/or BPM fail to teach or suggest, for example, "initiating performance of the selected one or more intellectual property services" (claim 1). The Office Action admits that BPM fails to disclose initiating performance of the selected services. The Office action contends, however, that the invention of claim 1 merely automates the manual process of initial consultation, search, application completion and filing of BPM. However, BPM still fails to provide information corresponding to services and to particular intellectual property matters. Although applicant does not concede that the claimed invention merely automates the manual process, even if the manual process were somehow automated, BPM and/or Inventnet still would not teach or suggest the invention, as claimed.

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The final office action argues that "the fact that the prior art fails to explicitly disclose specific well-known/inherent business techniques, such as the selection of the matter or service, completing a transaction, or selecting a jurisdiction or use the automation described in the instant invention is moot" (paragraph 113).¹ However, every limitation in the claim must be considered. A claimed invention cannot be dissected into discrete elements which are evaluated in isolation. "This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made." *Diamond v. Diehr*, 450 US 175, 188 – 89, 209 U.S.P.Q. 1, 9 (1981). Accordingly, each limitation must be considered, because the combination is patentable.

¹ It is unclear which elements (perhaps all) the examiner contends are inherent/well-known. Moreover, it is unclear whether the examiner considers them to be inherent, or well known. In any event, the contention that these elements are inherent is respectfully traversed. That something may occur or be present in the prior art, which applicant vigorously deny, is insufficient to establish inherency. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). In order to support a contention of inherency, the allegedly inherent characteristic must necessarily flow from the teachings of the reference. *In re Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). These particular elements do not necessarily flow from the cited references. Accordingly, the Examiner is respectfully requested to provide a citation to a reference or an Examiner's affidavit, or to withdraw the rejection. 37 C.F.R. § 1.104(d)(2); MPEP 2144.03.

Moreover, the taking of Official Notice is respectfully traversed, and the examiner is requested to provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. MPEP 2144.03 See 37 C.F.R. § 1.104(d)(2). An examiner may not simply reach conclusions based on their own understanding, or experience, or assessment of what would be basic knowledge or common sense. Rather, there must be "some concrete evidence in the record in support of these findings."), *In re Zurko*, 258 F.3d 1379, 1385, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001). Moreover, the examiner's expertise "may provide sufficient support for conclusions [only] as to peripheral issues." *Id.* at 1385-86, 59 U.S.P.Q.2d at 1697. It appears that the examiner is utilizing noticed facts to provide a motivation to modify Inventnet and/or BPM, hence, the noticed fact is clearly not a peripheral issue. Accordingly, it is inappropriate for the examiner to rely on official notice, and the examiner is requested to provide the above-mentioned affidavit or declaration.

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The failure of the examiner to consider each limitation, in combination, is apparent for example, where he equates the "type of intellectual property protection required" to "intellectual property matters." The preamble recites "transacting an intellectual property service in connection with the filing of documents and/or payment of fees for intellectual property matters;" the information that is provided corresponds to "one or more particular intellectual property matters;" and the performance of the intellectual property service for the intellectual property matter is initiated. As another example, claim 2 further recites that the service can be, e.g., the payment of an annuity. How one would initiate the payment of an annuity for a "type of intellectual property protection" makes no sense. The examiner's interpretation of the claim language is unreasonably broad because it calls for an inconsistent meaning when the limitations are considered in combination. Clearly, neither BPM nor Inventnet teaches or suggests "determining one or more intellectual property matters," as recited in combination.

It is respectfully submitted that claim 1 is patentable over the references, alone or in combination.

Claims 2 – 7 depend from independent claim 1, and are non-obvious for the foregoing reasons. In addition, with regard to dependent claim 2, Inventnet and/or BPM fail to teach or suggest, for example, details of the intellectual property services that may be selected. The final office action admits that BPM and Inventnet fail to teach or suggest this. However, the final office action argues that claim 2 is directed to nonfunctional descriptive material not functionally involved in the steps recited and therefore ignores the limitations of claim 2 in determining patentability. The examiner's characterization of claim 2 as being solely directed to nonfunctional descriptive material is incorrect. The examiner must determine (A) if the difference between the prior art and the claimed invention is limited to descriptive material

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stored on or employed by a machine, and (B) whether the descriptive material is functional or nonfunctional. This has not been done. To the contrary, first, the office action admits that the process recited in claim 2 is not shown in the prior art, and therefore part (A) of the test fails. Moreover, "initiating" performance of the service is functional. Therefore, part (B) of the test fails. It is therefore respectfully submitted that claim 2 is patentable over the references.

In connection with dependent claim 3, Inventnet and/or BPM fail to teach or suggest, for example, transacting the associated fees, substantially coincident with the performance of the services, and/or the details of the transacting of the associated fees as recited. The final office action admits that BPM and Inventnet fail to teach or suggest this. However, the final office action argues that claim 3 is directed to nonfunctional descriptive material not functionally involved in the steps recited and therefore ignores the limitations of claim 3 in determining patentability. The examiner's characterization of claim 3 as being directed to nonfunctional descriptive material is incorrect. The examiner must determine (A) if the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine, and (B) whether the descriptive material is functional or nonfunctional. This has not been done. To the contrary, first, the office action admits that the process recited in claim 3 is not shown in the prior art, and therefore part (A) of the test fails. Moreover, clearly the process of "transacting" which is "substantially coincident" with another step is functional. Therefore, part (B) of the test fails. It is therefore respectfully submitted that claim 3 is patentable.

With regard to dependent claim 4, Inventnet and/or BPM fail to teach or suggest, for example, presenting a user with, for particular intellectual property matters, "one or more target jurisdictions and one or more respective associates for each of at least a portion of said target jurisdictions," where the fees associated with a particular intellectual property service are

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"particularized by target jurisdiction and/or said one or more respective associates." The final Office Action contains a general response to applicant's arguments, contending that BPM and Inventnet disclose multiple tools, that these are well-known/inherent business techniques, and that incorporating these business techniques would have been obvious.² To the contrary, each limitation in the claim must be considered in determining patentability.

Now considering dependent claim 5, Inventnet and/or BPM fail to teach or suggest, for example, that the intellectual property matters is determined responsive to the docket, or that the information provided about the intellectual property services is "automatically" initiated, and is "in response to a docket event for a particular intellectual property matter corresponding thereto." To the contrary, neither Inventnet nor BPM teaches or suggests docket events for particular matters, and hence neither teaches or suggests automatically initiating the providing of such information. The final Office Action completely ignores applicant's arguments, and instead contains a general response to applicant's arguments, contending that BPM and Inventnet disclose multiple tools, that these are well-known/inherent business techniques, and that incorporating these business techniques would have been obvious.³ To the contrary, each limitation in the claim must be considered in determining patentability.

With respect to dependent claim 6, neither Inventnet nor BPM teaches or suggests, for example, "retrieving information" characterizing an intellectual property application corresponding to a particular intellectual property matter, "calculating the associated one or more fees" based on the retrieved intellectual property application information corresponding to the

² For the reasons provided above, the Examiner is respectfully requested to provide a citation to a reference or an Examiner's affidavit, or to withdraw the rejection. 37 C.F.R. § 1.104(d)(2); MPEP 2144.03.

³ For the reasons provided above, the Examiner is respectfully requested to provide a citation to a reference or an Examiner's affidavit, or to withdraw the rejection. 37 C.F.R. § 1.104(d)(2); MPEP 2144.03.

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intellectual property matter, and "at least partially completing target jurisdiction- and associate-specific documents" for the service from the retrieved information. The final Office Action completely fails to respond to applicant's specific arguments, and instead contains a general response to applicant's arguments, contending that BPM and Inventnet disclose multiple tools, that these are well-known/inherent business techniques, and that incorporating these business techniques would have been obvious.⁴ To the contrary, each limitation in the claim must be considered in determining patentability.

In connection with dependent claim 7, neither Inventnet nor BPM teaches or suggests, for example, supplying the information encoding the selected service(s) and the associated fee(s) "for use in an accounting system." Neither Inventnet nor BPM teaches or suggests a particular fee associated with a matter and a service, and hence certainly fail to teach or suggest that such a fee is sufficiently specific as to be used in an accounting system. Again, the final Office Action completely fails to respond to applicant's arguments, other than the general response that BPM and Inventnet disclose multiple tools; and that these are well-known/inherent business techniques, and that incorporating these business techniques would have been obvious.⁵ To the contrary, each limitation in the claim must be considered in determining patentability.

With regard to independent claim 11, Inventnet and/or BPM, alone or in combination, neither teach nor suggest, for example, "registering for each of plural associates, at least one target jurisdiction and a computer readable encoding of fees for one or more intellectual property services performed by the associate therein," or "determining, responsive to selection by the user

⁴ For the reasons provided above, the Examiner is respectfully requested to provide a citation to a reference or an Examiner's affidavit, or to withdraw the rejection. 37 C.F.R. § 1.104(d)(2); MPEP 2144.03.

⁵ For the reasons provided above, the Examiner is respectfully requested to provide a citation to a reference or an Examiner's affidavit, or to withdraw the rejection. 37 C.F.R. § 1.104(d)(2); MPEP 2144.03.

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of one or more specific matters and of one or more of the target jurisdictions and/or associates, matter-specific fees", or determining fees including "referencing the encoding of fees" (claim 11).

The office action admits that BPM fails to teach or suggest the determining step, as recited. The Office Action then argues that the claimed invention merely automates the manual activity of consultation between the associate and the user, search, application completion and filing. To the contrary, because the associates have registered at least one target jurisdiction and fees for services, and because the matter-specific fees are determined by referencing the registered fees, the step of consulting between the associate and the user is unnecessary. The omission of this step indicates that claim 11 is non-obvious.

Moreover, in connection with claim 1, the office action equates the "type of intellectual property protection required" to "intellectual property matters." How one would determine "matter-specific fees" for a "type of intellectual property protection" makes no sense. The examiner's interpretation of the claim language is unreasonably broad because it calls for an inconsistent meaning when the limitations are considered in combination. Clearly, neither BPM nor Inventnet teach or suggest "determining, responsive to ... one or more specific matters ..., matter-specific fees," as recited in combination.

It is respectfully submitted that independent claim 11 is patentable over the references for reasons including the foregoing.

Claims 12-14 depend from independent claim 11, and are non-obvious for the foregoing reasons. In addition, with regard to dependent claim 12, Inventnet and/or BPM fail to teach or suggest, for example, that the information distributed regarding the target jurisdiction, associates,

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and corresponding fee, is in response to a user selection of target jurisdiction(s) and "for each selected target jurisdiction, a respective one or ones of the associates."

Further, with regard to dependent claim 13, Inventnet and/or BPM fail to teach and/or suggest, for example, that the information is distributed by supplying "on a periodic basis", the computer readable encoding of fees.

Further with regard to claim 15, Inventnet and/or BPM, alone or in combination, neither teach nor suggest, for example, "an intellectual property service portal coupled by the network to the originating node and one or more of the target nodes," or "the intellectual property service portal ... supplying the originating node with information representative of one or more fees corresponding to the selected at least one intellectual property services," or "the intellectual property service portal ... transacting the one or more fees substantially coincident with the initiation thereof" (claim 15).

Specifically, the Office Action argues that BPM discloses being "responsive to a selection at the originating node of at least one intellectual property service". To the contrary, BPM's services are not selectable. BPM therefore does not do anything in response to selection of an intellectual property service.

The Office Action argues that the claimed invention merely automates the manual activity of consultation between the associate (e.g., the target node) and the user (e.g., the originating node), search, application completion and filing. To the contrary, the claims recite that the service portal supplies the originating node with information representing the fees, and the service portal transacts the fees. The step of consulting between the associate (e.g., the target node) and the user (e.g., the originating node) is unnecessary. The omission of this step indicates that claim 15 is non-obvious. "Omission of an element and retention of its function is an indicia

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of unobviousness." MPEP 2144.04; see also *In re Edge*, 359 F.2d 896, 149 U.S.P.Q. 556 (CCPA 1966).

Claims 16-20 depend from independent claim 15, and are non-obvious for the foregoing reasons. In addition, with regard to dependent claim 16, Inventnet and/or BPM fail to teach or suggest, for example, anything about fees for a "particular selected target jurisdiction and associate combination." Further, Inventnet and/or BPM fail to teach and/or suggest that the fees include the official fees for the filing in the particular jurisdiction, and the service fees of the selected associate for performing the selected service.

In addition, in connection with dependent claim 17, neither Inventnet nor BPM teaches or suggests, for example, that the target nodes coupled to the network include "computers of respective associates configured to electronically receive at least partial instructions concerning an intellectual property filing" from the originating node, via the intellectual property service portal.

Considering now claim 18, Inventnet and BPM fail to teach or suggest, for example, a web browser included in the originating node, a web server in the portal, and that the selection of the service, the supplying of the fee information, and the transacting of the fees, is achieved by internet protocol traffic between the web browser and the web server.

With respect to claim 19, neither Inventnet nor BPM teaches or suggests, for example, the registration by associates of information representative of "fees corresponding to the associate", and that the information that is supplied regarding fees, includes fees registered by the selected associates.

Further with regard to independent claim 21, Inventnet and/or BPM, alone or in combination, fail to teach or suggest, for example, a computer program with code "to select from

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amongst one or more intellectual property services... and to initiate performance...". Further, neither reference teaches or suggests code "to transact one or more fees".

The Office Action argues that the claimed invention merely automates the manual activity of consultation between the associate and the user, search, application completion and filing. To the contrary, because the fees are "associated with the selected one or more intellectual property services," the step of consulting between the associate and the user is unnecessary. The omission of this element indicates that claim 21 is non-obvious.

Claims 22 – 23 depend from independent claim 21, and are non-obvious for the foregoing reasons. In addition, with regard to dependent claim 22, Inventnet and/or BPM fail to teach or suggest, for example, that the selection code (to select amongst services and to initiate performance of the services) and the fee transaction code (to transact the fees for the selected services) are "all executable on a same processor."

It is respectfully submitted that the final office action fails to make a proper *prima facie* case of obviousness with respect to independent claim 24. The office action admits that BPM fails to teach or suggest any recited element, e.g., the means for selecting, the means for initiating, and the means for transacting. However, the office action states that BPM outlines fees and steps of the application process, and that it would have been obvious to simply automate the process including an electronic consultation. BPM fails to teach or suggest, however, anything about selecting at least one intellectual property matter, or performing services "for the at least one intellectual property matter;" or transacting fees "substantially coincident with the performance of the selected one or more intellectual property services."

Further with regard to claim 24, neither BPM nor Inventnet teach or suggest, alone or in combination, a system with means for selecting one or more intellectual property services and at

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least one intellectual property matter, means for initiating performance of the selected service(s) for the intellectual property matter, and/or means for transacting fees substantially coincident with the performance of the selected service(s).

Moreover, with respect to means plus function language, such as in independent claim 24, the Court of Appeals for the Federal Circuit, in its *en banc* decision *In re Donaldson Co.*, 16 F.3d 1189, 29 U.S.P.Q.2d 1845 (Fed. Cir. 1994), held that:

Per our holding, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination. (Emphasis added.)

Therefore, a "means or step plus function" limitation should be interpreted in a manner consistent with the specification disclosure. The Federal Circuit explained the two step analysis involved in construing means-plus-function limitations in *Golight Inc. v. Wal-Mart Stores Inc.*, 355 F.3d 1327, 1333-34, 69 U.S.P.Q.2d 1481, 1486 (Fed. Cir. 2004):

The first step in construing a means-plus-function claim limitation is to define the particular function of the claim limitation. ... The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function.

(*Id.*; citations omitted.) Here, the examiner has failed to consider the next step and accordingly has not looked at the specification. In some instances, the examiner has not considered structure specified in the claim.

The MPEP requires that the examiner must find that a prior art element: (A) performs the function specified in the claim, (B) is not excluded by any definition provided in the specification for an equivalent, and (C) is an equivalent of the means-plus-function limitation.

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Factors that will support a conclusion that the prior art element is an equivalent are: (1) the prior art element performs the identical function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification. *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 54 U.S.P.Q.2d 1308 (Fed. Cir. 2000); (2) a person of ordinary skill in the art would have recognized the interchangeability of the element shown in the prior art for the corresponding element disclosed in the specification. *Caterpillar Inc. v. Deere & Co.*, 224 F.3d 1374, 56 U.S.P.Q.2d 1305 (Fed. Cir. 2000); (3) there are insubstantial differences between the prior art element and the corresponding element disclosed in the specification. *IMS Technology, Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1436, 54 U.S.P.Q.2d 1129, 1138 (Fed. Cir. 2000); (4) the prior art element is a structural equivalent of the corresponding element disclosed in the specification. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990), i.e., the prior art element performs the function specified in the claim in substantially the same manner as the function is performed by the corresponding element described in the specification. (MPEP § 2183.)

The office action admits that the prior art does not perform the function specified in the claim. Therefore, claim 24 is allowable over the references.

With respect to claim 25, the office action argues that BPM and Inventnet disclose transacting fees substantially coincident with performance of the selected intellectual property services. Both references have been carefully reviewed without locating such disclosure. Accordingly, if the examiner maintains this rejection, applicant respectfully requests that he identify both the reference and the particular location therein for this teaching. Moreover, it is unclear if the rejection intends to refer to a combination of the references, and if so, which reference is cited for what part of the combination.

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With respect to claim 26, the office action argues that BPM and Inventnet disclose transacting fees prior to the performance of the selected intellectual property services. Both references have been carefully reviewed without locating such disclosure. Accordingly, if the examiner maintains this rejection, applicant respectfully requests that he identify both the reference and the particular location therein for this teaching. Moreover, it is unclear if the rejection intends to refer to a combination of the references, and if so, which reference is cited for what part of the combination.

With respect to claim 27, the office action argues that BPM and Inventnet disclose that the information is further particularized by the intellectual property matters. Both references have been carefully reviewed without locating such disclosure. Accordingly, if the examiner maintains this rejection, applicant respectfully requests that he identify both the reference and the particular location therein for this teaching. Moreover, it is unclear if the rejection intends to refer to a combination of the references, and if so, which reference is cited for what part of the combination.

With respect to claim 28, the office action argues that BPM and Inventnet disclose retrieving intellectual property application information corresponding to the particular intellectual property matter, and completing target jurisdiction- and associate-specific documents from the retrieved information. Both references have been carefully reviewed without locating such disclosure. Accordingly, if the examiner maintains this rejection, applicant respectfully requests that he identify both the reference and the particular location therein for this teaching. Moreover, it is unclear if the rejection intends to refer to a combination of the references, and if so, which reference is cited for what part of the combination.

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With respect to claim 29, the office action argues that BPM and Inventnet disclose registering forms as further recited. Both references have been carefully reviewed without locating such disclosure. Accordingly, if the examiner maintains this rejection, applicant respectfully requests that he identify both the reference and the particular location therein for this teaching. Moreover, it is unclear if the rejection intends to refer to a combination of the references, and if so, which reference is cited for what part of the combination.

With respect to claim 30, the office action argues that BPM and Inventnet disclose code for presenting a user with target jurisdictions and associates for target jurisdictions, where the fees for the particular services are further particularized by target jurisdiction and/or associate. Both references have been carefully reviewed without locating such disclosure. Accordingly, if the examiner maintains this rejection, applicant respectfully requests that he identify both the reference and the particular location therein for this teaching. Moreover, it is unclear if the rejection intends to refer to a combination of the references, and if so, which reference is cited for what part of the combination.

It is respectfully submitted that independent claim 31 is patentable over the references, for reasons including the following. The final office action admits that BPM fails to expressly disclose any recited step, including the determining step as recited, the providing step as recited, that the fees are calculated including retrieving the application information to determine the fees as recited, the selecting step, or the initiating step.

However, the office action argues that because BPM generally outlines steps in an application, it would be obvious to automate the process and supply electronic forms.

The office action admits that BPM particularly fails to disclose filing of documents and payment of fees relative to target jurisdictions/target associates. However, the office action

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contends that because Inventnet discloses registration and selection of target jurisdictions/target associations, it would be obvious to file documents and pay fees relative to such target jurisdictions / target associates. No reason is provided for modifying the combination of BPM/Inventnet to do anything with respect to fees, including retrieving intellectual property application for a particular matter and referring to the application to calculate the fees.

It is respectfully submitted that the office action has failed to make a prima facie case of obviousness, because all claim limitations are not taught by the references in the detail as recited.

It is respectfully submitted that independent claim 32 is patentable over the references, for reasons including the following. The final office action admits that BPM fails to expressly disclose the selection code, the fee transaction code, or the instruction code, as recited.

However, the office action argues that because BPM generally outlines steps in an application, it would be obvious to automate the process by completing the steps electronically, including an electronic consultation and by providing the necessary forms.

The office action admits that BPM particularly fails to disclose filing of documents and payment of fees relative to target jurisdictions/target associates. However, the office action contends that because Inventnet discloses registration and selection of target jurisdictions/target associations, it would be obvious to file documents and pay fees relative to such target jurisdictions / target associates. No reason is provided for modifying the combination of BPM/Inventnet to do anything with respect to fees, including retrieving intellectual property application for a particular matter and referring to the application to calculate the fees.

It is respectfully submitted that the office action has failed to make a prima facie case of obviousness, because all claim limitations are not taught by the references in the detail as recited.

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Hence, BPM and Inventnet, alone or in combination, fail to teach or suggest the combination of features recited in claims 1, 4 – 7, 11 – 13, 15 – 19, 21, 22, and 24 – 32.

Furthermore, BPM and/or Inventnet operate in a fundamentally different way than the claimed invention. The combination as proposed by the Examiner would be, at most, a directory of law firms and their marketing materials in multiple jurisdictions. The Office Action cites the multiple target jurisdictions in Inventnet as disclosing one or more target jurisdictions; however, BPM and Inventnet, alone or in combination, are clearly deficient considering the invention as a whole. Consequently, the proposed combination fails to teach or suggest the claimed invention.

Claims 2, 3, 14, 20 and 23 were rejected under 35 U.S.C. § 103 as being unpatentable over BPM in view of Inventnet. The Office action argues that the only differences between the claimed invention and BPM in combination with Inventnet are found in nonfunctional descriptive material. The rejection is respectfully traversed. These claims are deemed to be patentable for reasons including, *inter alia*, their direct or indirect dependency from allowable base claims.

B. There is no Prima Facie case of obviousness where there is no motivation to combine the references.

In addition, there is no suggestion or motivation to combine the references. "There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." In re Oetiker, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). Moreover, to establish a prima facie case of obviousness, "it is necessary for the examiner to present evidence, preferably in the form of some teaching, suggestion, incentive, or inference in the applied prior art, or in the form of generally available

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knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention." In re Levengood, 28 U.S.P.Q.2d 1300, 1301 (Bd. Pat. App. 1993).

Failure to point to specific information that teaches or suggests the combination claimed cannot support a conclusion of obviousness. In re Dembiczak, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). "Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." In re Kotzab, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). See also, Crown Operations Int'l Ltd. v. Solutia Inc., 289 F.3d 1367, 1376, 62 U.S.P.Q.2d 1917 (Fed Cir. 2002) ("there must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, ... to look to particular elements, and to combine them as combined by the inventor.").

The Office Action provides no motivation to combine the references, other than a broad, conclusory statement in paragraph 19 of the Office Action that the combination of "one or more target jurisdictions as disclosed by Inventnet in the system disclosed by BPM" would be made "for the advantage of providing a method of transacting an intellectual property service with the ability to widen customer services capabilities in a multitude of jurisdictions (US and foreign)." One cannot glean from Inventnet a motivation either to begin transacting intellectual property services, or to combine its patent attorney directory or other materials with, e.g., BPM's on-line law firm marketing materials. Nor can one glean from BPM's law firm marketing materials a motivation to include a directory of other attorneys.

In determining whether a suggestion can be fairly gleaned from the prior art, one must consider the full field of the invention, "including that which might lead away from the claimed

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invention." In re Dow Chemical, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). It would be unusual for law firm marketing materials, such as BPM, to include a directory of other competitive attorneys. Inventnet instructs its users themselves to use a patent attorney to prepare the necessary documents ("Patenting Help" page screen). Hence it appears that the references implicitly and explicitly lead away from the invention as claimed.

Moreover, assuming *arguendo* that it may have been possible to access both over the Internet, that in itself provides no motivation to combine the references as proposed by the Examiner. To the contrary, where the prior art does not suggest the combination or convey a reasonable expectation of success of making it, there is no *prima facie* case of obviousness. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The claimed subject matter "as a whole" must be considered in determining obviousness. E.g., Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 449, 230 U.S.P.Q. 416, 420 (Fed. Cir. 1986). Here, because there is no motivation for the combination of Inventnet and BPM, and even the proposed combination fails to teach at least one feature taken in combination with the remainder of features of the claimed invention, the Examiner has failed to establish obviousness generally, as well as the requisite *prima facie* case. Accordingly, applicant is not presenting, at this time, objective evidence tending to support a conclusion of non-obvious, since no such evidence is necessary at this time.

C. The Proposed Combination fails to teach or suggest the invention as a whole.

Assuming *arguendo* the suggested motivation, the proposed combination of references still fails to teach or suggest the invention as claimed. For example, the combination of BPM and

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Inventnet still fail to provide a method of transacting intellectual property transactions in multiple jurisdictions.

The claimed subject matter "as a whole" must be considered in determining obviousness. E.g., Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., *supra*. Here, the proposed combination fails to teach at least one feature taken in combination with the remainder of features of the claimed invention.

Assuming *arguendo* a motivation to combine the two references, the proposed modification would appear to change the principle of operation of either BPM or Inventnet, or both. Inventnet claims to be an Internet based inventor's network. The Office Action argues that Inventnet "discloses the registration and selection of one or more target jurisdictions/agents". Assuming *arguendo*, without admitting, that InventNet provides the teaching as contended in the Office Action, it is not clear how the registration or selection of one or more target jurisdictions would further teach or suggest the registration and/or selection of one or more intellectual property services (claims 1, 15, 21, 24, 31, 32), or selection of intellectual property matters (claim 8), or selection of jurisdiction and fees for intellectual property services (claim 11). Hence, the proposed combination would appear to be antithetical to the fundamental principles of BPM, in order for BPM to accommodate Inventnet in the manner proposed by the Examiner.

Moreover, it appears that the Examiner is impermissibly relying on hindsight, including applicant's own disclosure and references available only after the filing date of the present application. "[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teaching of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

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The fact that an invention in hindsight may be simple, does not mean the invention is not patentable. As stated by the Federal Circuit:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting claims 1, 2, and 4-9 under 35 U.S.C. § 103(a) over Evans. Moreover, because the rejections of claims 3 and 10 rely upon the foregoing, we also conclude that the Board did not make out a proper *prima facie* case of obviousness in rejecting those claims under 35 U.S.C. § 103(a).

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000).

For at least these reasons, the combination of features recited in independent claims 1, 11, 15, 21, 24, 31 and 32, when interpreted as a whole, is submitted to patentably distinguish over the prior art.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 1, 11, 15, 21 or 24, but also because of additional features they recite. Examples of some of these features were discussed previously.

For all the reasons advanced above, applicant respectfully submits that the rejection of claims 1 - 7 and 11 - 32, must be reversed.

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D. The References Teach Away From the Claimed Invention.

A prior art reference must be considered in its entirety, including portions that would have lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied 469 US 851 (1984). Where the reference teaches away from the claimed invention, it is a significant factor and must be weighed in substance. Further, known disadvantages in old devices would naturally discourage a search for new inventions, and must be taken into consideration in determining obviousness. United States v. Adams, 383 US 39, 52, 148 U.S.P.Q. 479, 484 (1966).

BPM discloses that providing estimated fees and costs is not really possible. Specifically, BPM states:

Many of our clients have asked for a way of estimating what costs and time periods to expect when pursuing a patent on their inventions. This estimator should serve as a guide, and *is as good an estimate as we can prepare, but you should realize that the fees you will actually pay may vary widely from these, depending on the individual circumstances of your invention.*

...
BPM states the following about Foreign Filing:

In general: *It is not really possible to accurately estimate the total cost of foreign filing in a generalized way, since it varies so widely depending on what countries are chosen, what method of filing is pursued, the fees of foreign patent attorneys in each country, exchange rates, translations, etc. ... We can try to give you an estimate for your specific situation based on your fact pattern, once you have a US application on file.*

BPM teaches that fees cannot be provided in advance. BPM states "It is not really possible to accurately estimate...." "We can try to give you an estimate for your specific

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situation ..." (Emphasis added.) Consequently, the fees are not transacted, as claimed, when the claims are interpreted as a whole.

BPM is a reference teaching away from the claimed invention, and is highly relevant and is a significant factor to be considered in determining obviousness. The known and acknowledged difficulty of providing estimates is highly relevant. It appears that these known difficulties or impossibilities would naturally discourage a search for a new invention both providing specific fees and transacting the specific fees, as claimed.

Hence, the disclosure of BPM would have led a person of ordinary skill in the art away from the use of fees and costs which are sufficiently definite that they can be transacted.

In view of the foregoing, the applicant respectfully submits that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,



Cynthia K. Nicholson
Reg. No. 36,880

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Posz Law Group, PLC
12040 South Lakes Drive, Suite 101
Reston, VA 20191
Phone 703-707-9110
Fax 703-707-9112
Customer No. 23400